

REMARKS

Claims 2-40, 42-43, 45, 47-66, 68-73, and 83 have been cancelled without prejudice.

Applicants reserve the right to prosecute the subject matter of the cancelled claims at a later date.

Claims 1, 41, 67, 74-82, and 84-85 have been amended. Claim 1 has been amended to incorporate allowable subject-matter. No new matter has been added.

The Examiner states that the "application contains claims 1-7, 10-15, 17-18, 21-24, 33-44, 46-53, 67-75 [which] read on to an invention nonelected with traverse" See Office Action at p. 2. The Examiner contends that "[a] complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action or other appropriate action (37 CFR 1.144) See MPEP § 821.01." *Id.* Applicants have cancelled the previously withdrawn claims.

Claims 1, 41, 44, 46, 67, 74-82 and 84-85 are pending.

CLAIM OBJECTIONS

The Examiner has objected to claims 41, 76-82, and 84-85 "as being dependent upon a rejected base claim" and has indicated that those claims "would be allowable if rewritten in independent form including all of the limitations of the based claims and any intervening claims." See Office Action at p. 2. Applicants thank the Examiner for kindly indicating allowability of these claims. Applicants further request that claim 74 and 75 be found allowable since the Examiner has indicated the allowability of claim 41.

In an effort to expedite prosecution and not in acquiescence to the rejections, claim 1 has been amended to incorporate compounds indicated by the Examiner to be allowable. Applicants reserve the right to prosecute the subject matter of the remaining claims in a divisional or continuation application.

CLAIM REJECTIONS

Rejection of claims under 35 U.S.C. §102(b) over Parsons

The Examiner has rejected claims 1-2, 4-7, 9-10, 12, 17-18, 40, 42 and 44-46 under 35 U.S.C. 102(b) as being anticipated by WO 98/55449 to Parsons et al ("Parsons"). See Office Action at p. 2. Applicants respectfully traverse this rejection. Claim 9 and 45 were cancelled in

the Response to Office Action filed on January 10, 2006, thus rendering this rejection moot with respect to these claims. Claims 2, 4-7, 10, 12, 17-18, 40 and 42 have been cancelled thus rendering this rejection moot with respect to those claims. Claims 44 and 46 are dependent on independent claim 1.

In an effort to expedite prosecution and not in acquiescence to the rejection, claim 1 has been amended to include allowable subject matter. Parsons does not describe a method of inhibiting histone deacetylation activity in cells that includes contacting the cells with an effective amount of a compound wherein the compound is 5-phenyl-2,4-pentadienoic acid, 7-phenyl-2,4,6-heptatrienoic acid, 7-phenyl-2,4,6-hepta-trienoylhydroxamic acid, 8-phenyl-3,5,7-octatrienoic acid, cinnamoylhydroxamic acid, methyl-cinnamoylhydroxamic acid, 5-phenyl-2,4-pentadienoylhydroxamic acid, N-methyl-5-phenyl-2,4-pentadienoylhydroxamic acid, 3-methyl-5-phenyl-2,4-pentadienoylhydroxamic acid, 4-methyl-5-phenyl-2,4-pentadienoyl hydroxamic acid, 4-chloro-5-phenyl-2,4-pentadienoylhydroxamic acid, 5-phenyl-2-en-4-yn-pentanoylhydroxamic acid, or N-methyl-6-phenyl-3,5-hexadienoylhydroxamic acid, thereby treating one or more disorders mediated by histone deacetylase and determining whether the level of acetylated histones in the treated cells is higher than in untreated cells under the same conditions. See amended independent claim 1. None of the compounds described by Parsons are compounds recited in independent claim 1.

Accordingly, independent claim 1 is not anticipated by Parsons. Claims 44 and 46 depend from claim 1 and are therefore patentable over Parsons for at least the reasons described above. Applicants respectfully request reconsideration and withdrawal of this rejection.

Rejection of claims under 35 U.S.C. §103 over Parsons

The Examiner has further rejected claims 1-2, 4-7, 9-10, 12, 17-18, 40, 42, 44-46 and 83 under 35 U.S.C. 103 as being unpatentable over Parsons. Claim 9 and 45 were cancelled in the Response to Office Action on January 10, 2006, thus rendering this rejection moot with respect to these claims. Claims 2, 4-7, 10, 12, 17-18, 40, 42 and 83 have been cancelled thus rendering this rejection moot with respect to those claims. Claims 44 and 46 depend from independent claim 1. Applicants respectfully traverse this rejection.

In an effort to expedite prosecution and not in acquiescence to the rejection, claim 1 has been amended to include allowable subject matter. Parsons does not teach or suggest a method of inhibiting histone deacetylation activity in cells that includes contacting the cells with an effective amount of a compound as recited in amended independent claim 1. None of the compounds taught by Parsons are within the scope of claim 1.

Since claims 44 and 46 are dependent on claim 1, they are patentable over Parsons for at least the reasons described above. Applicants respectfully request reconsideration and withdrawal of this rejection.

CONCLUSION

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the pending rejections. Applicants believe that the claims now pending are in condition for allowance.

Should any fees be required by the present Amendment, the Commissioner is hereby authorized to charge Deposit Account **19-4293**.

Respectfully submitted,

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